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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/426,793 | 10/23/1999 | DONALD C MANN | ULT-001 | 2355 |
| 22888 | 7590 | 11/30/2004 | EXAMINER | |
| BEVER HOFFMAN & HARMS, LLP TRI-VALLEY OFFICE 1432 CONCANNON BLVD., BLDG. G LIVERMORE, CA 94550 | | | FRECH, KARL D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/426,793 | MANN ET AL. | |
| | Examiner | Art Unit | |
| | Karl D Frech | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-45,74-104 and 112-124 is/are pending in the application.
- 4a) Of the above claim(s) 116-124 is/are withdrawn from consideration.
- 5) Claim(s) 89-104 is/are allowed.
- 6) Claim(s) 1,2,7-11,13,15,16,21-45,74,78-85 and 112 is/are rejected.
- 7) Claim(s) 3-6,12,17-20,75-77,86-88 and 113-115 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12,8/26,8/27 2004
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. Applicant's preliminary amendment filed 1/20/04 has been entered as paper number 10. The examiner acknowledges that claims 112-115 were inadvertently withdrawn from consideration in the rejection of 10/3/02 (paper number 5). Claims 1-45, 74-104, 112-115 are now pending.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-45, 74-104, 112-115, drawn to a magnetic card, classified in class 235, subclass 493.
 - II. Claims 116-124, drawn to a floppy disk, classified in class 360, subclass 99.04.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a common PC memory storage device. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. Newly submitted claims 116-124 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 116-124 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is reminded that claims 116-124 must be officially canceled before this application may be ultimately allowed.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1,2,7-11,13,15,16,21-45,74,78-85,112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choki et al 5,356,717.

Choki discloses as seen in figures 6 and the related specification in column 4 lines 29+, a card having a substrate 21, a magnetic storage layer 31 and a protective layer(s) 32/33. The protective layer consists of hiding layer 32 and a coating layer 33. There is an intermediate design layer 41 between the magnetic layer 31 and the top protective layer 33. It is disclosed that the layer is between 0.01-10 micrometers. Choki does not specifically disclose the relative motion of the scanning of the magnetic layer. However, if not inherent, it is old and well known to move a magnetic layer relative to a magnetic read head in reading of the magnetic information. It would have been obvious to one of ordinary skill in the art at the time of the invention to move the magnetic card passed a read head in order to allow the magnetic card of Choki to be read in a conventional and existing magnetic card reader. Choki does not disclose that the data storage device is generally circular in shape. However, this is a matter of design choice as circular codes are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a generally circular substrate shape in order to allow the card of Choki to be read by a means with also a generally circular reading capability, for example, a disk drive in a PC.

11. Claims 89-104 are allowable over the prior art of record.

12. Claims 3-6,12,17-20,75-77,86-88,113-115 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Applicant's arguments, filed 8/27/04, With respect to claims 3-6,12,14,17-20,75-77,86-104,113,114,115 have been fully considered and are persuasive. The rejection of these claims has been withdrawn.

With respect to claims 3-6,14,17-20,76,77,86,87,91,92,98,99,113,114, Applicant argues that the "magnetic properties" of the protective layer, which comprises the hiding layer coating layer, is not shown in Choki. As specifically claimed, there is a "magnetically saturable material" in this protective layer. Upon reconsideration, the examiner agrees.

With respect to 12,88,115, the examiner agrees that Choki does not disclose the "lubricant layer" or "lubrication layer".

Regarding claims 4,6,87,114. Applicant argues that Choki does not show "a non-magnetic friction reducing layer". However, as seen above, this argument is moot as these claims the examiner agrees that there is not a "magnetically saturable material" disclosed by Choki.

Regarding claims 14,18-20 Applicant argues that Choki does not show the "diamond like carbon layer". However, as seen above, this argument is moot as these claims the examiner agrees that there is not a "magnetically saturable material" disclosed by Choki.

Regarding claims 75,89, the examiner agrees that there is no "of a diamond-like hardness" suggested by Choki, as argued by Applicant.

Regarding claims 89-96,97-104 the examiner agrees that there is no "exchange break layer" as now claimed suggested by Choki.

14. Applicant's arguments filed 8/27/04 regarding claim 30 have been fully considered but they are not persuasive. Applicant argues that the "rotatably mounted within said substantially planar and generally rectangular shaped substrate" is not shown by Choki. However, in reviewing the previous rejection, it is pointed out that the examiner relied upon the fact that circular magnetic codes were old and well known and therefore would have been obvious. In support, the examiner no cites Lemelson et al 4,592,042.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech
Primary Examiner
Art Unit 2876
